

REMARKS

The present communication is responsive to the Official Action mailed April 27, 2006.

Claims 1-25 and 17-45 are pending in the application. No amendments to the claims have been made. For the reasons discussed herein, applicants respectfully traverse the Examiner's rejections and request the Examiner to reconsider patentability of the pending claims based on the arguments herein.

The Examiner rejected claims 1-24 and 27-42 under § 35 U.S.C. § 103(a) as allegedly being unpatentable over *Dias* (US 6,540,791) in view of *Ridel et al.* (US 6,156,296). The Examiner explained that although *Dias*, the primary reference, does not specifically teach the use of polyhydroxycarboxylic acids as claimed in the instant application, *Dias* teaches a general hair bleaching composition comprising oxidizing agents. The Examiner combined *Dias* with *Ridel et al.*, the secondary reference, and explained that *Ridel et al.* teaches a composition comprising α -hydroxycarboxylic acids including galactaric (mucic) acid and galactonic acid which fall within the scope of the claimed formula (I) as recited in claims 1-6 in the instant application. The Examiner then concluded that in view of the teaching of the secondary reference, one having ordinary skill in the art would be motivated to modify the compositions of *Dias* by incorporating the hydroxycarboxylic acids taught by *Ridel et al.* to arrive at the claimed invention. Applicants respectfully traverse this rejection.

First, as the Examiner has correctly pointed out in the Office Action, *Dias* does not teach an oxidizing composition having a hydroxycarboxylic having the general formula (I) recited in all of the pending claims of the instant application.

In an effort to remedy the deficiencies of *Dias*, the Examiner combines *Dias* with *Ridel et al.* The Examiner stated

that "*Ridel et al.* i[s] analogous art of hair bleaching formulation (see col.10, ll.32-33), teaches a composition comprising α -hydroxycarboxylic acids, wherein the α -hydroxycarboxylic acids include galactaric (mucic) acid and galactonic acid that are represented by the claimed formula (I)." However, applicants respectfully disagree with the Examiner's conclusion since it is the result of an impermissible exercise in hindsight reconstruction. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998) (hindsight reconstruction cannot be used to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention).

"'Common knowledge and common sense' . . . do not substitute" for evidence of a "specific hint or suggestion" to combine prior art. *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430 (Fed. Cir. 2002); see also *In re Dembiczak*, 175 F.3d 994, 997, 1000, 50 USPQ2d 1614 (Fed. Cir. 1999) (trash bag having a Halloween pumpkin design is not *prima facie* obvious in the absence of evidence of suggestion to combine normal trash bag with references describing pumpkin designs on paper bag). Moreover, a combination "could have been made" is not sufficient to support a finding of obviousness. *KSR International Co. v. Teleflex, Inc.*, *Teleflex Inc. v. KSR Intern. Co.*, 119 Fed.Appx. 282 (Fed. Cir. 2005), *cert. granted sub nom, KSR Intern. Co. v. Teleflex Inc.*, No. 04-1350 (2006) (appeal pending before the U.S. Supreme Court).

In the present case, *Ridel et al.*, the secondary reference, is mainly teaching a hair cosmetic formulation for restoring and/or preventing the damages caused by hair treatments, such as coloring, bleaching and/or reshaping of hair, comprising a **combination** of phytosterols and α -hydroxycarboxylic acids. There is no teaching in *Ridel et al.* as to the effectiveness of α -hydroxycarboxylic acids when used

alone in the absence of phytosterols in a hair coloring, bleaching or reshaping composition.

Therefore, without the improper hindsight reconstruction, one of ordinary skill in the art would not be motivated to combine *Dias* and *Ridel et al.* to arrive at the present invention having an oxidizing composition comprising an oxidizing agent and a hydroxycarboxylic acid having the general formula (I). Accordingly, applicants respectfully submit that claims 1-14 and 27-42 are not obvious in view of *Dias* and *Ridel et al.*

Secondly, the Examiner rejected claims 26 and 43-45 as allegedly being unpatentable over *Dias* in view of *Di La Mettrie et al.* (US 6,254,646). The Examiner stated that *Di La Mettrie et al.* is analogous art of hair treating formulation and teaches a process for reshaping hair comprising the step of applying to the hair a reducing composition followed by applying an oxidizing composition as claimed in claims 43-45. With respect to claim 25, the Examiner stated that *Di La Mettrie et al.* clearly teaches a reducing composition and an oxidizing composition which implies that the two compositions are separated from each other to arrive at the claimed invention. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness under Section 103, the references relied upon for rejection must suggest the entirety of the claimed invention and, hence, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Dias, the primary reference cited by the Examiner, fails to teach all of the elements of the present invention, even if combined with the secondary reference, *Di La Mettrie et al.*, since both of these two references do not mention the

specific hydroxycarboxylic acids required by the claims of the instant application.

As mentioned above, and noted by the Examiner in the Official Action, *Dias* does not disclose the specific hydroxycarboxylic acids having the general formula (I). Similarly, *Di La Mettrie et al.* also fails to disclose the specific hydroxycarboxylic acids having the general formula (I) shown above. Therefore, the combination of *Dias* and *Di La Mettrie et al.* fails to teach the essential element of the present invention, and therefore the prima facie case of obviousness has not been established.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this response, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 26, 2006

Respectfully submitted,

By 

Kelly Y. Hwang

Registration No.: 51,831

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant